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10/714,582	11/13/2003	Wayne Franklin Chip Burton JR.	009-4040	1700

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EXAMINER

RANGREJ, SHEETAL

ART UNIT

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3626

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/714,582

Applicant(s)

CHIP BURTON ET AL.

Examiner

SHEETAL R. RANGREJ

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Prosecution History Summary

- Claims 1, 10, and 12-16 have been amended.
- Claims 1-16 are pending.

DETAILED ACTION

Drawings

1. Based on Applicant's amendments and arguments, the Examiner has withdrawn the drawing rejections.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Haller et al. (U.S. Publication No. 2002/0013613).
4. As per claim 1, Haller teaches a method of compensating an operator of a defibrillator for expenses incurred as a result of using the defibrillator, the method comprising the steps of:
 - receiving a pre-determined monetary amount from the operator (**Haller: para. 0178**);
 - maintaining a contractual relationship with the operator for a period of time in exchange for the pre-determined monetary amount (**Haller: para. 0191**) the contractual relationship including a

requirement to reimburse the operator for at least a portion of the expenses incurred as a result of using the defibrillator for the benefit of the other party if the external defibrillator is used during the period of time (**Haller: para. 0178; para. 0188**).

Applicant has amended claim 1, by adding the limitations external defibrillator and wherein the contractual relationship includes a requirement to reimburse the operator. As per this element, Haller does not explicitly teach wherein the contractual relationship includes a requirement to reimburse the operator. The limitation of the contractual relationship including a requirement to reimburse is a non-functional descriptive material. A clause within a contract could include a reimbursement clause, but the clause itself is a non-functional descriptive material. The invention is drawn to a contract including a clause to reimburse the operator. Any health related contract is representative of containing clauses related to reimbursement.

In response to applicant's arguments, the recitation "external defibrillator" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

5. As per claim 2, the method of claim 1 is as described. Haller further teaches wherein maintaining step comprises maintaining contractual relationships with a plurality of operators (**Haller: para. 0191**).

6. As per claim 3, the method of claim 2 is as described. Haller further teaches further comprising the step of allocating the expenses across the plurality of operators (**Haller: para. 0189**). The examiner interprets that allocation of expenses were done due to reimbursements.
7. As per claim 4, the method of claim 1 is as described. Haller further teaches wherein the receiving step is executed upon purchase of the defibrillator (**Haller: para. 0185**). The examiner interprets that receiving a service and providing a charge for the service is the same as receiving an amount from the operator at the time of purchase.
8. As per claim 5, the method of claim 4 is as described. Haller further teaches wherein the receiving step is executed at a regular interval corresponding to the period of time (**Haller: para. 0188-0189**).
9. As per claim 6, the method of claim 5 is as described. Haller further teaches wherein the regular interval further corresponds to a period of contract for maintenance of the defibrillator (**Haller: para. 0189**).
10. As per claim 7, the method of claim 5 is as described. Haller further teaches wherein the period of time is annually (**Haller: para. 0191**).
11. As per claim 8, the method of claim 5 is as described. Haller further teaches wherein the period of time is monthly (**Haller: para. 0191**).
12. As per claim 9, the method of claim 4 is as described. Haller further teaches wherein the receiving step is executed in conjunction with receipt of a lease payment (**Haller: para. 0191**).
13. As per claim 10, the method of claim 1 is as described. Haller further teaches further comprising the step of requesting compensation for the reimbursement provided in the reimbursing step from the other party (**Haller: para. 0188-0189**).

14. As per claim 11, the method of claim 1 is as described. Haller further teaches wherein the period of time continues in perpetuity (**Haller: para. 0191**).

15. As per claim 12, Haller teaches a method of insuring against costs associated with external defibrillator use, the method comprising:

-establishing contractual relationships with a plurality of external defibrillator operators, each contractual relationship comprising a period of time (**Haller: para. 0191**);

-receiving premium payments from each of the external defibrillator operators (**Haller: para. 0176**); and

-providing reimbursement to one of the plurality of external defibrillator operators for the costs associated with external defibrillator use in a response to another party undergoing a medical emergency if a defibrillator event occurs during the period of time (**Haller: para. 0178; para. 0188**).

The reference fails to teach the method directed for an external defibrillator. However, the difference between the reference (prior art) and claims 12, 15, and 16 relates only to the intended use of the invention (i.e., to the types of defibrillator). A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim limitation.

Haller does not explicitly teach a method of insuring costs associated with an external defibrillator. However, Haller discloses a method of insuring costs that can be applied to a variety of products/goods, regardless of the intended field of use of the method. Haller teaches a method of insuring costs associated with an internal defibrillator, though the method/system has

utility in other applications. The method/system being adapted to an external defibrillator is irrelevant since the intended use does not change the overall functionality of the method. The intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill in the art to use the Haller method towards an external defibrillator because the Haller system is designed to be used towards any product/goods regardless of the intended use.

Examiner takes Official Notice that using an external defibrillators in response to another party undergoing a medical emergency is an old and well known usage in the healthcare art. It would have been obvious at the time of the invention to one of ordinary skill in the art to use the defibrillator of Haller for a purpose of assisting another party undergoing a medical emergency.

16. As per claim 13, the method of claim 12 is as described. Haller further teaches further comprising the step of seeking compensation for the reimbursement from the other party (Haller: para. 0178; para. 0188).

17. As per claim 14, the method of claim 12 is as described. Haller further teaches further comprising the step of seeking compensation for the reimbursement from an insurance carrier associated with the other party (Haller: para. 0178; para. 0188).

18. System claim 15 repeat the subject matter of claim 1 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Haller in the above rejection of claim 1, it is readily apparent that the Haller reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 1 and incorporated

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herein.

19. System claim 16 repeat the subject matter of claim 12 as a set of “means-plus-function” elements rather than a series of steps. As the underlying process has been shown to be fully disclosed by the teachings of Haller in the above rejection of claim 12, it is readily apparent that the Haller reference includes a system to perform the recited functions. As such, these limitations are rejected for the same reasons provided in the rejection of claim 12 and incorporated herein.

Response to Arguments

20. Applicant's arguments filed for claims 1-16 have been fully considered but they are not persuasive.

Response to Amendment

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 12/19/2007 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Haller, based on the logic and sound scientific reasoning of one of ordinary skill in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (mailed: 09/19/2007).

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Davies, C. Sian, et al. Defibrillators in public places: the introduction of a national scheme for public access defibrillation in England. *Resuscitation* 52(2002), pp. 13-21.
- Business Editors/Health & Medical Writers. ZOLL Medical announces multi-year agreement with Novation. New York: August 24, 1999, pp. 1-2.

-Business Editors/Health & Medical Writers. HP to supply CodeMaster XL + the ForeRunner defibrillators to Carilion Health System. New York: August 5, 1998, pp. 1-2.

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571)270-1368. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SRR

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626